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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,651	07/02/2003	Motohiro Hatano	KASAP037	4615

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EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT PAPER NUMBER

3683

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,651

Applicant(s)

HATANO ET AL.

Examiner

Christopher P. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

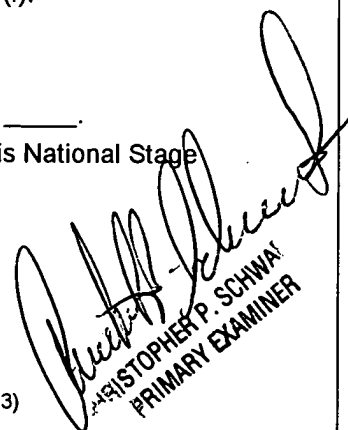
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.


CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

DETAILED ACTION

1. Applicant's amendment filed 6/22/04 has been received.

Claim Rejections - 35 USC § 112

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 last three lines "said flexible portion" now lacks antecedent basis. It appears "portion" should be changed to "partition".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,8,9,10 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese publication 9-229128.

Regarding claim 1, '128 discloses an inner shaft 5, an outer sleeve 6, an elastic body 7, a flexible layer 17, a flexible partition 13, a pressure receiving chamber 21 (radially inside of element 10), an equilibrium chamber 22, and an annular orifice defining member at 10 all as claimed. Note the flexible partition 13 includes a cylindrical portion (in the area of numeral 12) axially protruding from an inner peripheral "portion" of the orifice defining member toward the elastic body. It may also be interpreted as "axially protruding" from the annular curved portion in the area of numeral

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13. This cylindrical portion is attached to the inside of the orifice defining member (of which any small piece may be considered to be a "portion") and extends axially in the direction of the elastic body 7. Note the annular curved portion in the area of numeral 13.

Regarding claim 8 these requirements are met, as broadly claimed.

Regarding claim 9 as broadly claimed these requirements are met since the annular curved portion does not reach the elastic body, but rather extends away from it.

Regarding claim 10 these requirements are met.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over '128.

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Regarding claim 3 although '128 lacks showing the flexible partition 13 is formed of a spring stiffness greater than that of the flexible layer, to have modified the device of '128 according to the claimed spring stiffnesses would have been obvious to the ordinary skilled worker in the art at the time of the invention dependent upon the damping characteristics desired from the damping device.

8. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over '128 in view of Kanda.

Regarding claim 4, '128 lacks showing a restricting member as claimed.

It is noted that the restricting member may be an optional feature in applicant's invention, as discussed in the specification at page 22 lines 9 and 10:

Kanda discloses this well known and utilized member at 20. Note that Kanda extends the elastic member at 26 to incorporate this element.

One having ordinary skill in the art at the time of the invention would have found it obvious to have modified the elastic body 7 of '128 to include a restricting member, as taught by Kanda, dependent upon the intended/optional mounting arrangements for the '128 damping device.

Regarding claims 5,6 these limitations are merely an alternate equivalent arrangement to that shown by '128, as modified by Kanda. Note the use of the claimed rubber stopper mechanisms are notoriously well known in the art.

Regarding claim 7 note the modification above to '128 by Kanda in the area of 26, for the reasons given, would meet these requirements.

Allowable Subject Matter

9. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 6/22/04 have been fully considered but they are not persuasive. Applicant's simply list some of the features recited in claim 1 and then allege that the Japanese publication '128 fails to "teach at least the essential feature (d) mentioned above".

However, as explained in the action, '128 meets all of the claimed limitations of at least claim 1.

The limitations listed in part (d) of applicant's remarks are incorrect in that they are not found in claim 1.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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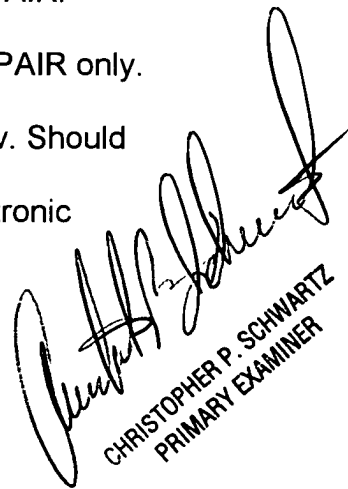
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cps
9/4/04



CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER